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10/669,357	09/25/2003	Aziz Hassan	BSN5DIV	6637

7590

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EXAMINER

CAMERON, ERMA C

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/669,357

Applicant(s)

HASSAN ET AL.

Examiner

Erma Cameron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-46 is/are pending in the application.
- 4a) Of the above claim(s) 43, 44 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-42 and 45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 30-46 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12-6-04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

#### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

- a) claims to a composition not claimed to be adhesive (claims 30-42 and 45);
- b) claims to an adhesive composition (claims 43-44 and 46).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the

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limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Ben Appelbaum on May 26, 2005 a provisional election was made without traverse to prosecute the invention of group a), claims 30-42 and 45. Affirmation of this election must be made by applicant in replying to this Office action. Claims 43-44 and 46 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Double Patenting***

4. The rejection of Claims 18-28 under 35 U.S.C. 101 as claiming the same invention as that of claims 18-28 of prior U.S. Patent No. 10/137689 is withdrawn because of the amendment filed 5/16/2005, canceling claims 1-29 and adding new claims 30-46.

At the time the double patenting rejection was made, claims 18-28 of the instant application and claims 18-28 of 10/137689, drawn to the same invention, were pending. Therefore, the double patenting rejection was properly made.

Applicant states on page 10 of the 12/6/2004 amendment that claims 1-17 and 29 should be the pending claims. However, claims 1-17 and 29 had been canceled in the 9/25/2003 preliminary amendment.

Claims 30-46 are now the pending claims.

***Specification***

5. The disclosure is objected to because of the following informalities:

a) The amendments to the specification in the 12/6/2004 amendment are not entirely well-defined, as to page and line. The page 17 amendment should be on line 10. The page 18 amendment is actually on page 17, line 30. (This refers to the specification as filed).

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Only the page 12 amendment agrees with the new specification as filed 12/6/2004. The other two amendments to the specification do not agree with the page/line numbers of the new specification.

The amendments should be resubmitted, with a clear reference to which version of the specification is being amended.

b) Table 2: the definition of \* has been omitted from this Table.

### *Drawings*

6.

a) The drawing submitted 12/6/2005 is acceptable.

However, the drawing appears to be of the prior art, rather than of the claimed invention, and if it is, it should be labeled as prior art.

b) It is not clear what is meant by Brief Description of the Several Views of the Drawing on page

8. What are the several views?

*Claim Rejections - 35 USC § 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 30-42 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claims 30 and 45: warm has not been defined and is therefore vague. The term "warm" is a relative term which renders the claim indefinite. The term "warm" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

b) Claims 30 and 45: dispersible is vague in that it is not clear whether or not dispersion actually takes place. In addition, if dispersion takes place, it is not clear at what point it takes place – before or after application to the cellulosic material.

c) Claims 31-32, 34-35 and 37: the phrase "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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d) Claim 38: does not agree with independent claim 30, which says that the composition consists essentially of, not comprising.

e) Claim 40: contradicts claim 30, that limits the oils to vegetable sources. Claim 40 claims some animal sources.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 30-42 and 45 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for composition that can be dispersed in an alkaline aqueous solution, does not reasonably provide enablement for dispersal in a solution that is not alkaline.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

See page 14, line 20 (as filed), and elsewhere in the specification. It appears that an alkaline solution is a requirement for dispersion.



***Claim Objections***

11. Claim 42 is objected to because of the following informalities:

- 200/mg/g/KOH (typo).

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 30-42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeter (6011286).

'286 teaches enhancing water resistance of materials such as fiberboard (1:54-67) with a composition of low iodine value (preferably 0-30, 1:40-52) triglyceride fats from plant or animal sources (2:21-46), such as a soy stearine (see Example 1), which is a triglyceride with stearic acid (see attached printout from the Registry file).

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'286 does not disclose the MP or saponification value of the triglyceride, but because stearine is one of the triglycerides claimed by applicant, the stearine of '286 would inherently have the same MP and saponification value as that claimed by applicant.

'286 does not disclose the viscosity of the wax emulsions used in its examples, but it would have been obvious to one of ordinary skill in the art to have optimized the viscosity through no more than routine experimentation because viscosity is known to be an important parameter to control in coatings.

'286 does not disclose the addition of dispersants, named as such, in its examples, but the Archer 1, referred to as a "synergistic adhesive" (5:33), may serve as a dispersing agent in the emulsion. Furthermore, it would have been obvious to one of ordinary skill in the art to have added a dispersant to an emulsion, because dispersants are conventional additives to emulsions.

Dry particles of the triglyceride may be sprayed onto the substrate (3:1-19), which means that the composition is then 100% triglyceride, thereby meeting claim 41.

'286 discloses that the triglyceride may be used as a water emulsion (3:1-19), thereby meeting the requirement that the composition is "dispersible in a warm aqueous solution".

14. Claims 30-38, 40-42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/00815.

'815 teaches applying a coating containing a triglyceride such as tristearin or a hardened vegetable oil to a paperboard, in order to make the coated paperboard more repulpable. Tristearin is a triglyceride with stearic acid (see the attached printout from the Registry file). Additives

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such as beeswax, a type of paraffin (page 5), may also be present. The coating composition may be applied in the molten state (p 5), thus meeting the requirements of 100% of claim 41. It is disclosed that the triglycerides may be removed from the paperboard by several different means, including hot water (pp 6-7). See pages 2-7.

'815 does not disclose the iodine value, MP or saponification value of the triglyceride, but because tristearin is one of the triglycerides claimed by applicant, a triglyceride with stearic acid, the tristearin of '815 would inherently have the same iodine value, MP and saponification value as that claimed by applicant.

'815 does not disclose the viscosity of the wax emulsions used in its examples, but it would have been obvious to one of ordinary skill in the art to have optimized the viscosity through no more than routine experimentation because viscosity is known to be an important parameter to control in coatings.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
ERMA CAMERON  
PRIMARY EXAMINER

Erma Cameron  
Primary Examiner  
Art Unit 1762

May 26, 2005